

## REMARKS

Claims 1–22, 25, 26, and 36–50 are pending. Claims 5, 7, 14, 15, 17–22, 36–39, and 45–50 are withdrawn from consideration.

### Amendments to the Claims

Claim 1 has been amended to recite “wherein the lumen is dimensioned for the passage of surgical instruments therethrough”. Claims 6 and 44 have been amended to recite “dimensioned for the passage of surgical instruments therethrough”. Support for these amendments is found in the Specification, for example, on page 5, lines 12–13 (“The tubular body may be a thin walled tube sized and configured to allow passage of surgical instruments through the body wall and into the body cavity.”).

### Rejections Under 35 U.S.C. § 102

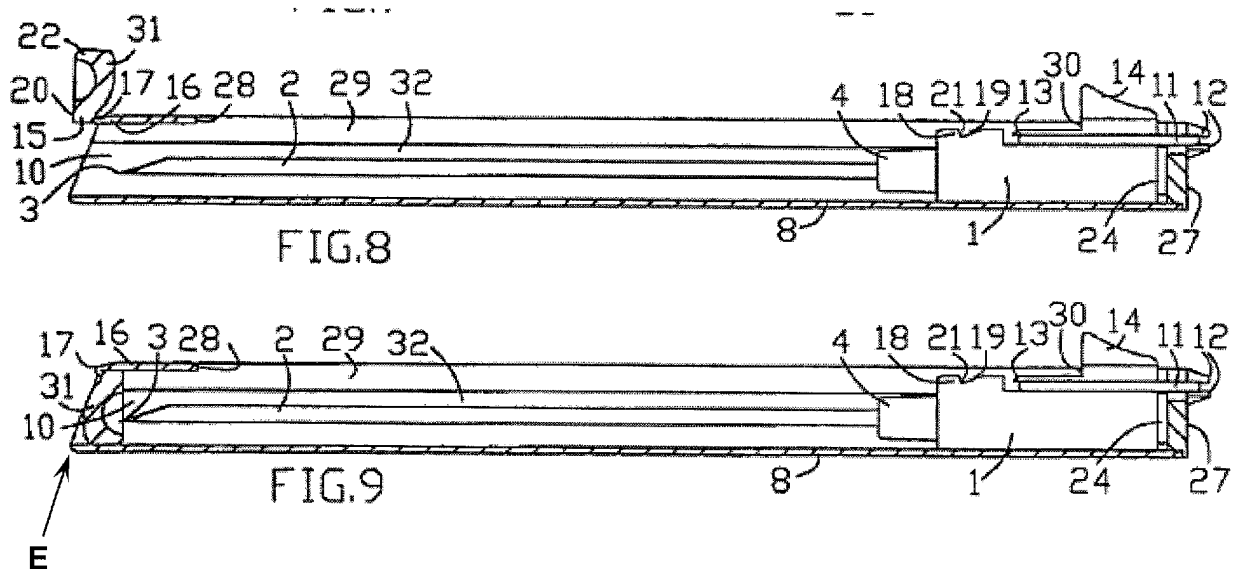
“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

Claims 1, 3, 8, and 40–44 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 7,422,572 (Popov). Independent claim 1, as amended, recites in part “the lumen is dimensioned for the passage of surgical instruments therethrough”. Independent claim 44 as amended recites in part “the elongate tubular body ... dimensioned for the passage of surgical instruments therethrough”. Popov does not disclose this feature. The Examiner characterizes an outside security zone **10** of a compact catheter insertion device illustrated in FIG. **9** of Popov as corresponding to the recited lumen. Neither the Specification nor the drawings in Popov disclose, either expressly or inherently, or suggest that the outside security zone **10** is dimensioned for passage of surgical instruments therethrough.

Claim 1 also recites in part “a tissue penetrating tip”. Claim 44 recites in part “a tip connected to and disposed at the distal end of the tubular body for penetrating through a body wall and into the body cavity”. The Examiner refers to lid **31** illustrated in FIGS. **8** and **9** of Popov as corresponding to the recited feature. The Examiner states that the lid **31** “is capable of penetrating through a body wall” because “the tip of Popov is sharp pointed or bladed, Fig. 9.”

Popov does not disclose or suggest that the lid 31 is sharp pointed or bladed, or is capable of penetrating through a body wall. FIGS. 8 and 9 of Popov are reproduced below. The only element that possibly corresponds to a sharp point or blade is indicated by the reference character E below. Comparing FIGS. 8 and 9, E is a part of the handle 8, not the lid 31. No portion of the lid 31 is sharp pointed or bladed.

Moreover, comparing FIGS. 8 and 9, in the configuration illustrated in FIG. 9, the lid 31 is *recessed within the end of the handle 8*. Consequently, in the configuration illustrated in FIG. 9, the lid 31 is not capable of penetrating through a body wall.



For at least the above reasons, claims 1 and 44 are not anticipated by Popov. Because claims 3, 8, and 40-44 are dependent on claim 1, these claims are also not anticipated by Popov for at least the same reasons.

### Rejections under 35 U.S.C. § 103

Obviousness is a question of law based on underlying factual inquiries set forth in *Graham v. John Deere*: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the claimed invention and the prior art; and (3) resolving the level of ordinary skill in the pertinent art. Objective evidence of non-obviousness must be also considered. In assessing the differences between the claim and the cited references, every feature of the claim must be disclosed or suggested in the cited references or known to one skilled in the

art in making a *prima facie* case of obviousness. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003). A *prima facie* case of obviousness also requires a reasonable expectation of success in the modification or combination of references, which must be found in the cited references or must be known to one skilled in the art. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 2, 4, 6, 9–13, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Popov in view of U.S. Patent No. 5,626,598 (Roth). The Examiner relies on Roth only for disclosing a blunt or conical trocar tip. Claims 2, 4, 12, 13, 25, and 26 are dependent on claim 1. As discussed above, Popov does not disclose or suggest every feature recited in claim 1. Consequently, Popov and Roth do not disclose or suggest every feature recited in claims 2, 4, 12, 13, 25, and 26, and these claims are allowable over the cited reference for at least the same reason.

Independent claim 6 as amended recites in part “an elongate tubular body ... dimensioned for the passage of surgical instruments therethrough” and “a tissue penetrating tip”. As discussed above, Popov does not disclose or suggest either feature. Because the Examiner does not rely on Roth for disclosing these features, claim 6 is allowable over the cited reference for at least this reason. Because claims 9–11 are dependent on claim 6, claims 9–11 are allowable for at least the same reason.

Claim 16 stands rejected under rejected under 35 U.S.C. § 103(a) as unpatentable over Popov. Claim 16 is dependent on claim 1. Because claim 1 is allowable over Popov, as discussed above, claim 16 is also allowable for at least the same reasons.

#### **No Disclaimers or Disavowals**

Although the present paper may include a combination of alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding that previously pending claims in this application are not patentable over the cited references. Rather, any alterations and/or characterizations are made to facilitate prosecution of this application. Applicants reserve the right to pursue any previously pending, or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or in any prior prosecution. Accordingly,

Application No. 10/805,864

Responsive to an Office Action dated May 12, 2009

Response filed August 5, 2009

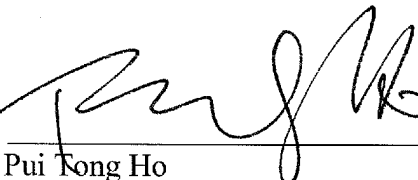
reviewers of this or any parent, child, or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

### **Conclusion**

Applicants submit that all of the Examiner's rejections have been addressed and overcome, and that all claims are allowable over the art of record. Applicants have submitted amendments and arguments believed to be sufficient to overcome all of the outstanding rejections. Consequently, Applicants have not advanced every argument for the allowability of the claims over the references of record. As such, Applicants do not acquiesce to any of the Examiner's statements or characterizations not specifically traversed. Should the Examiner believe that any outstanding issues are resolvable in an Examiner's Amendment, the Examiner is invited to contact the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 01-2215.

Respectfully submitted,  
APPLIED MEDICAL RESOURCES

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